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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,755	09/17/2001	Henri Jacques Suermondt	10007909	8507

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EXAMINER

HIRL, JOSEPH P

ART UNIT

PAPER NUMBER

2121

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/954,755	SUERMONDT ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Joseph P. Hirl	2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 September 2001.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                               | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.<br>_____.<br>_____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

1. Claims 1-16 are pending in this application.
2. The claims and only the claims form the metes and bounds of the invention.

"Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

### ***Specification***

3. The specification is objected to because of the following:

The specification at page 11, lines 7-15 cites: "The accuracy 18 provides an indication of a degree of correctness in the classification rendered by the classifier 12 where the correctness is provided by the authoritative classifier 14. The accuracy 18 may be viewed as providing a measure of distance between the zero or more categories selected by the classifier 12 for the item 10 and the one or more categories

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selected by the authoritative classifier 14 for the item 10." The specification does not identify a methodology for distance calculation.

Claim 1 of the specification at lines 7-10 cites "...a set of categories of an arrangement of categories selected for an Item by the classifier..." and "...a set of categories of the arrangement selected for the item by an authoritative classifier..." The writings indicate that both "sets of categories" are distinct or independent.

The specification principally focuses on a measure of accuracy for classifier 12. As the calculations are developed for classifier 12 and ultimate in reference to accuracy 18, the relationship to how the authoritative classifier with its independent set of categories effects the accuracy is not addressed at specification pages 7-11. To one of ordinary skill in the art, there would be undue experimentation to establish a methodology, determine the separate and independent set of categories, and then determine the degree of correctness that is based on distance.

These objections must be corrected.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the invention focuses on the use of an

authoritative classifier 14 that is defined by the specification at page 7, lines 15-16, to be “...a human expert ...” It is axiomatic that from one human expert to another, classifications would be different reducing the claims to a level of uncertainty or indefiniteness.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Para 2 above applies. Specifically, the invention focuses on the use of an authoritative classifier 14 that is defined by the specification at page 7, lines 15-16, to be “...a highly accurate automated classifier ...” Such a general claims would read on a Bayesian classifier using some transformation  $F(x)$  on the observed data where such data might experience some preprocessing. To apply such a concept without disclosing how it would be implemented would require undue experimentation by one of ordinary skill in the art. And yet, the claim is of such generality that it covers such a situation. Hence, the generality drives the lack of enablement in the specification.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

10. The practical application test requires that a useful, concrete and tangible result be accomplished. Claims 1-16 represent abstract methodology with human being processing. The abstract methodology establishes rejection on the basis of intangibility. Further, it is axiomatic that from one human expert to another, classifications would be different establishing rejection on the basis of lack of concreteness. Either rejection establishes the consequence of non-statutory.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

A person shall be entitled to a patent unless –

12. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Peele et al (USP 5,561,431 referred to as Peele).

**Claim 1**

Peele anticipates determining a set of categories of an arrangement of categories selected for an item by the classifier (Peele, c 8, l 30-52); determining a set of categories of the arrangement selected for the item by an authoritative classifier (Peele, c 8, l 30-52); determining an accuracy measure for the item which indicates a degree of correctness of the classifier based on the categories selected by the classifier and the categories selected by the authoritative classifier (Peele, c 8, l 53-67; c 9, l 1).

**Conclusion**

13. The prior art of record and not relied upon is considered pertinent to applicant's disclosure.

Johnson et al, USP 6,212,532

Barnhill et al, USP 6,306087

14. Claims 1-16 are rejected.

**Correspondence Information**

15. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is

(703) 305-1668. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anil Khatri can be reached at (703) 305-0282.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,  
Washington, D. C. 20231;

or faxed to:

(703) 746-7239 (for formal communications intended for entry);

or faxed to:

(703) 746-7290 (for informal or draft communications with notation of "Proposed" or "Draft" for the desk of the Examiner).

Hand-delivered responses should be brought to:

Receptionist, Crystal Park II  
2121 Crystal Drive,  
Arlington, Virginia.

Joseph P. Hirl



November 4, 2003



ANIL KHATRI  
SUPERVISORY PATENT EXAMINER